

No. 14674

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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HOMER E. GILLESPIE, CATHERINE L. GILLESPIE and GILLESPIE GAMES COMPANY, a Corporation,

*Appellants,*

*vs.*

COMA F. NORRIS, Individually and Doing Business as  
C. F. NORRIS MANUFACTURING COMPANY,

*Appellee.*

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APPELLANTS' OPENING BRIEF.

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ERIC A. ROSE,

711 F. & M. Building,  
Long Beach 12, California,

*Attorney for Appellants.*

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## APPELLANTS' OPENING BRIEF.

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### Pleadings and Facts Disclosing Basis of Jurisdiction.

This action was instituted in the United States District Court in and for the Southern District of California, Central Division, entitled Homer E. Gillespie, Catherine L. Gillespie, Gillespie Games Company, a California Corporation, plaintiffs, vs. Coma F. Norris, individually and doing business as C. F. Norris Manufacturing Company, defendants, No. 16858-WM, by way of complaint for infringement of U. S. Letters Patent No. 2,595,669, charging defendants with infringement of said letters patent. After answer was filed, defendants made a motion for summary judgment, and said motion was submitted to the trial court on affidavit and counter-affidavits. The mo-

tion for summary judgment was granted, and judgment was entered adjudging claims No. 1, 2, 3, 11, 12, 13 and 14 of the above named letters patent to be invalid and dismissing the complaint on the merits. [Tr. pp. 73-74.]

Judgment was signed on December 30, 1954, and notice of appeal was filed on behalf of appellants by their attorneys on January 20, 1955 [Tr. pp. 74-75], wherein they appeal to the United States Court of Appeals for the Ninth Circuit, from the above-stated judgment.

The statutory basis for jurisdiction of the District Court is U. S. C., Title 28, Sec. 1338(a), and the statutory basis for the jurisdiction of this Court is U. S. C., Title 28, Sec. 1291 and Sec. 1292(4).

### Statement of the Case.

After complaint and answer thereto was filed, defendants moved the Court to enter, pursuant to Rule 56 of the Federal Rules of Civil Procedure, a summary judgment in defendants' favor. The motion was based on certain affidavits to which plaintiffs had filed counter-affidavits which in fact denied all matters stated in the affidavits supporting the motion. [Tr. pp. 39-69.]

The file wrappers of Letters Patent No. 2,595,669 and its parent application, Serial No. 796,523, were offered and received in evidence during the hearing on the motion.

The parties stipulated that the copy of Letters Patent No. 2,595,669 to Gillespie [Tr. Vol. II, pp. 89-98], was true and correct. [Tr. p. 64.]



Defendants claimed, and the Court sustained their contention, that W. E. Andrews Patent No. 2,160,349 [Tr. Vol. II, pp. 82-84], and L. J. Dorsey Patent No. 725,684 [Tr. Vol. II, pp. 86-88], anticipated the patent in suit, and particularly that claims 1, 2, 3, 11, 12, 13 and 14 of said Letters Patent were invalid because not new, totally lacking in invention, and anticipated. The motion for a summary judgment was granted on these grounds, and findings of fact and conclusions of law were filed accordingly. [Tr. pp. 71-72.]

### **Specification of Errors Relied Upon by Appellants.**

1. The evidence is insufficient to support the findings or conclusions particularly as it relates to

- (a) Invention,
- (b) Novelty,
- (c) Anticipation.

2. The Court erred in granting defendants' motion for summary judgment based upon the Dorsey and Andrews patents as anticipatory of the Gillespie patent.

## ARGUMENT.

### I.

#### Patent No. 2,595,669 Discloses Invention.

The basic element claimed in the claims involved in the instant action is "a horizontal stationary launching platform disposed a sufficient distance above said playing field and outside of said housing and forming a slit-like opening with said cover so that disc-like playing pieces may be manually trajected from said platform through said slit-like opening and through the air onto said playing field!

The question of invention is a question of fact and not of law.

*Wire Tie Machine Company v. Pacific* (C. C. A. 9), 102 F. 2d 530;

*Crowell v. Baker* (C. C. A. 9), 153 F. 2d 972;

*Pointer v. Six Wheel* (C. C. A. 9), 177 F. 2d 153.

Courts have dealt however with the question of invention as though it were one of law. This conflict can only be explained by breaking the question of patentable invention down into its component parts: what the prior art was and what the patentee did to improve upon it, and then, whether what the patentee did is properly to be classified as an invention. The nature of the prior art, it has been held, and the nature of what the patentee did to improve upon it must always be *questions of fact*. The question of the name to be given to what was done by the patentee, whether it is to be called an invention under the prior art or whether it is not, is a question

fundamentally of the meaning of the words used in the statute. (35 U. S. C., Sec. 31.)

*Hanovia v. David Buttrick Co.* (C. C. A. 1), 27 F. 2d 888;

*Nat. Slug Rejectors v. A. B. T. Manu. Corp.* (C. C. A. 7), 164 F. 2d 333.

When there is doubt as to the question of invention, the confirmation arising from the issuance of a patent may avail to resolve the doubt in favor of *its* validity.

*Elec. Vacuum Cleaner Co. v. P. A. Geier Co.* (C. C. A. 6), ..... F. 2d 221.

The Court is called upon to decide whether reasonable minds may differ upon the question whether the patent in suit involves invention. Because of the restricted scope of a motion for summary judgment, no evidence is before the Court that while the penny pitch game is old, and the relative return is small, the costs of an operator have been the source of many business failures, and *the industry has since its inception been in urgent need of a device which would eliminate the operator and protect the revenue from unauthorized interference.* In spite of the fact that such need was urgent, no one has apparently thought of the idea disclosed by the patent at bar. *The fact that a device or method satisfies an old and recognized want is highly persuasive of invention.*

*Levin v. Coe* (App. D. C.), 132 F. 2d 589.

A material contribution to a crowded art is indicative of invention.

*Robinson v. Hughes* (C. C. A. 5), 176 F. 2d 783.

Utility, economy, efficiency, or other advantage, may be evidence of invention.

*Pyle Nat. Co. v. Lewin* (C. C. A. 7), 92 F. 2d 628.

Satisfaction of long-felt want was held evidence of invention.

*Nat. Lock Washer Co. v. Geo. K. Garrett Co.* (C. C. A. 3), 98 Fed. 643.

Giving the Andrews and Dorsey patents the effect to which they are legally entitled, it is unquestionably true that the result achieved by the instant patent was neither contemplated nor described in the prior art cited.

One who produces a patentable new result, the simplicity of which effects a saving of time and costs, not suggested by the references, is entitled to a patent.

*Application of Ott* (C. C. P. A.), 182 F. 2d 209.

Increased efficiency is evidence of invention.

*Iron Fireman Mfg. Co. v. Industrial Eng. Corp.*, (C. C. A. 7), 89 F. 2d 904.

It is respectfully submitted that evidence of the above stated attributes applicable to the instant invention would constitute evidence to be submitted at the trial of the instant action, and such attributes must be decided as questions of fact on which this Court cannot rule by reason of the limited scope of the motion. The evidence would further disclose that after receiving the information published in the patent, the game industry welcomed the new device with open arms, and that the exploitation of the patent was highly successful wherever marketed, and further that defendant attempted to saturate the Southern



California market with devices embodying plaintiffs' invention *after* the device was disclosed to him by plaintiffs.

It is respectfully submitted that for the foregoing reasons and based upon the above stated authorities, the Court erred in ruling that the patent at bar did as a matter of law not disclose invention.

## II.

### Patent No. 2,595,669 Discloses Novelty.

The trial court in its decision states that plaintiffs' device is not novel.

It has been repeatedly held that in order to negative novelty or, as it is usually expressed, to "anticipate" an invention, it is necessary that all of the elements of the invention or their equivalents be found *in one single* description or structure where they do substantially the same work in substantially the same way.

*Imhaeuser v. Buerk* (1879), 101 U. S. 647, 660, 25 L. Ed. 945;

*Bates v. Coe* (1878), 98 U. S. 31, 25 L. Ed. 68.

*Ottumwa Box Car Loader Co. v. Christy Box Car Loader Co.* (C. C. A. 8), 215 Fed. 362;

*Ventilated Cushion & Spring Co. v. D'Arcy* (C. C. A. 6, 1916), 232 Fed. 468;

*Dow Chem. Co. v. Williams Bros. Well Treating Co.* (C. C. A. 10, 1936), 81 F. 2d 495, 501;

*Universal Oil Products Co. v. Winkler-Kock E. Co.* (D. C., D. Del., 1934), 6 Fed. Supp. 763, 770, *aff'd* 7 F. 2d 991, (C. C. A. 3, 1935.)

A patent relied upon as an anticipation must itself speak. Its specification must give in substance the same

knowledge and the same directions as the specification of the patent in suit.

*Southern Phosphate v. Phosphate Recovery* (C. C. A. 3), 102 F. 2d 801.

Plaintiffs' device provides a launching platform from which playing pieces are propelled upon the playing surface. The device permits the player to aim and direct the playing piece to the target on the paying surface. At the same time the device prevents tampering with the playing pieces deposited upon the playing surface.

The Andrews patent does not teach any part or portion of the result achieved by plaintiffs' invention. Claim 1 of Andrews specifically provides "*vertical slots of a width for the slidable passage of the tokens and of a length substantially greater than the major dimension of the token, and said board being of a thickness sufficient to prevent deviation of the token from a vertical plane while passing through the slots.*"

The Andrews device is therefore specifically constructed to *prevent* aiming and directing of the tokens. One of the chief purposes of the instant patent is therefore *intentionally* defeated in the Andrews patent.

The Dorsey device provides an elastic "shooting-platform" permitting the player to make "changes in the elevation or the depression of the plane of projection." There is nothing in the specification or claims of this patent which indicates that Dorsey either visualized or intended to provide the device patented by Gillespie.

It is respectfully submitted that in view of the fact that neither Andrews nor Dorsey describe or intimate that they intended to cover the subject matter of the instant

patent, this Court should not speculate on a motion for summary judgment whether a person skilled in the instant art would have arrived at Plaintiffs' construction, particularly in view of the fact that *in spite of the urgency with which the game industry required the solution disclosed in Plaintiffs' patent, Gillespie was the person who 45 years after issuance of the Dorsey patent and 11 years after issuance of the Andrews patent first disclosed this labor saving device to the public.*

This court held in *Payne v. Williams etc. Co.* (C. C. A. 9, 1941), cert. den. 313 U. S. 572, 85 L. Ed. 1530, that prior patents cannot be reconstructed in the light of the invention involved in a patent infringement suit, *and then used as a part of the prior art.* However, that is exactly what the trial court must have done in order to arrive at the statement that Dorsey and Andrews were anticipatory to Gillespie.

Alleged anticipatory patents must stand on their own published disclosures and can be considered as teaching the art *only those things that can be found in them.*

*Mead v. Hillman* (C. C. A. 7), 135 F. 2d 955;

*Dewey v. Mimex* (C. C. A. 2), 124 F. 2d 986;

*Novelty is a question of fact.*

In *B. F. Sturtevant v. Mass. Hair and Felt Co.* (C. C. A. 1), 122 F. 2d 900, cert. den. 315 U. S. 823, 86 L. Ed. 1219, the Court states at page 908:

"The question of priority of invention, even when the attempt is made to invalidate a patent by showing an earlier one rather than by merely showing prior general knowledge and use, is, like the question of patentable invention, one of fact. 1 Walker on Pat-

ents, Deller's Edition sec 61 United States v Esnault-Pelterie, 303 U. S. 26, 30, 31, 58 S. Ct. 412, 82 L. Ed. 625. The reason for this is that '*it is not the construction of the instrument, but the character of the thing invented*, which is sought in questions of identity and diversity of inventions.' Bischoff v. Wethered, 9 Wall. 812, 76 U. S. 812, 816, 19 L. Ed. 829." (Emphasis by the Court.)

The only authority on which the trial court relied, invalidating plaintiffs' claims, in its Order on Defendants' Motion for Summary Judgment is the decision of this Court in *Jacuzzi Bros. v. Berkeley Pump Co.*, 191 F. 2d 632. [Tr. pp. 69-70.]

The last named case was *fully tried*, and the Court decided as a matter of *fact*, and not of *law*, that the claims in issue were invalid. Appellant asked this Court in the last cited case to hold that there was invention as a *matter of law*, which this Court in accordance with the settled law relating to the presumption of the correctness of the findings of the trial court, refused to do. There is absolutely no basis for the assertion by the trial court in the instant case that "no trier of fact could reasonably find that the device described . . . is either new or the result of invention." [Tr. p. 70.]

Judge Learned Hand answered the trial court's statement in *Kirsch etc. Co. v. Gould etc. Co.* (C. C. A. 2), 6 F. 2d 793, 794, better than the writer of this brief could, as follows:

"An invention is a new display of ingenuity beyond the compass of the routineer, and in the end that is



all that can be said about it. Courts cannot avoid the duty of divining as best as they can what the day to day capacity of the ordinary artisan will produce. This they attempt by looking at the history of the art, the occasion for the invention, its success, its independent repetition at about the same time, and the state of the underlying art, which was a condition upon its appearance at all. Yet, when all is said, there will remain cases when we can only fall back upon such good sense as we may have, and in these we cannot help exposing the inventor to the hazard inherent in hypostatizing such modifications in the existing arts as are within the limited imagination of the journeyman. There comes a point when the question must be resolved by a *subjective opinion* as to what seems an easy step and what does not. We must try to correct our standard by such objective references as we can, *but in the end the judgment will appear, and no doubt be, to a large extent personal, and in that sense arbitrary.*"

As has been stated, Novelty as well as patentable invention are questions of fact. Judge Hand's definition, given above, indicates *why* it should be decided as a question of fact.

It is respectfully submitted that the trial court erred in making the issues presented by the pleadings from the jury and deciding *all* issues as a matter of law.

The key elements listed by Judge Hand, namely (1) History of the Art; (2) Occasion of the Invention; (3) Its success; (4) Its independent repetition at about the same time; (5) the State of the underlying art, which was a condition upon its appearance at all; all of these

questions were quite obviously not considered for the reason that the Court had no evidence before it to support an opinion on it.

For the foregoing reasons, and based upon the above cited authorities, it is therefore respectfully submitted that the judgment should be reversed.

Respectfully submitted,

ERIC A. ROSE,

*Attorney for Appellants.*